

REMARKS

Initially, Applicants would like to express their appreciation to the Examiner, Mr. Alvin Stewart, for the courtesy of the telephone interview conducted with their attorney Ms. Linda Hodge, on May 5, 2006. During the telephone interview, the claims were discussed and compared to the prior art applied by the Examiner in the rejections, *i.e.*, LIN (U.S. Patent No. 6,080,158; LIN (U.S. Patent No. 6,325,827); and BRANTIGAN (U.S. Patent No. 5,425,772). No agreement was reached. Also during the telephone interview, the rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 112, first paragraph, was discussed. It was agreed that deleting the phrase "and entirely covering the upper and lower surfaces of the body" in claim 1 would likely overcome the rejection. Accordingly, Applicants have presented claim 1, amended as noted above, in order to obtain withdrawal of the rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 112, first paragraph.

Applicants would also like to express appreciation to the Examiner for the detailed Final Official Action provided.

Upon entry of the above amendment, claims 1 and 6 will have been amended. Accordingly, claims 1, 2, and 4-6 are currently pending. Applicants respectfully request reconsideration of the outstanding rejections and allowance of claims 1, 2, and 4-6 in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

The Examiner has rejected claims 1, 2, and 4-6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner has taken the position that the phrase "and entirely covering the upper

and lower surfaces of the body” contains new matter. In response thereto, Applicants have amended claim 1 to delete the phrase “and entirely covering the upper and lower surfaces of the body”. Accordingly, in view of the above noted amendments and remarks, it is believed that the rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 112, first paragraph, has been overcome and Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 112, first paragraph.

The Examiner has rejected claims 1, 2, 4, and 5 under 35 U.S.C. §103(a) as being unpatentable over LIN ‘158 (U.S. Patent No. 6,080,158) in view of LIN ‘827 (U.S. Patent No. 6,325,827).

Although Applicants do not necessarily agree with the Examiner's rejection of claims 1, 2, 4, and 5 on this ground, nevertheless, Applicants have amended independent claim 1 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. Applicants respectfully submit that LIN ‘158 and LIN ‘827 fail to teach or suggest the subject matter claimed in claim 1, as amended. In particular, claim 1 sets forth an intervertebral spacer having a withdrawal preventer including, inter alia, “a body defined by a pair of upper and lower surfaces, a pair of side surfaces connected to the upper and lower surfaces, a front side of the intervertebral spacer, and a rear side of the intervertebral spacer”; and “wherein the withdrawal preventer comprises a plurality of linear claw portions continuously extending from one side surface of the body to the other side surface”. This amendment is fully supported by the specification, including the claims and drawings, and no prohibited new matter has been added. In particular, support for the above amendment can be found at least in the figures.

The LIN '158 intervertebral fusion device includes a body formed by a plurality of body portions separated by upward elastic slots 110 and downward elastic slots 111. Therefore, the body (*i.e.*, the entire body including all of the body portions and all of the elastic slots therebetween) extends from the front side of the intervertebral fusion device to the rear side of the intervertebral fusion device, but includes interruptions therein. Accordingly, since the body and the claw portions thereon in the LIN '158 device include interruptions therein, Applicants' claimed withdrawal preventer including linear claw portions *continuously extending from one side surface of the body to the other side surface* cannot fairly be read on the body including interruptions of LIN '158. Further, each body portion of the LIN '158 device extends only partially from the front side of the fusion device to the rear side of the fusion device. No body portion of the LIN '158 device "is defined" by a pair of upper and lower surfaces, a pair of side surfaces, and "a front side of the intervertebral spacer, and a rear side of the intervertebral spacer". Accordingly, the LIN '158 patent fails to show an intervertebral spacer including, inter alia, "a body defined by a pair of upper and lower surfaces, a pair of side surfaces connected to the upper and lower surfaces, a front side of the intervertebral spacer, and a rear side of the intervertebral spacer"; and a withdrawal preventer "wherein the withdrawal preventer comprises a plurality of linear claw portions continuously extending from one side surface of the body to the other side surface", as recited in claim 1, as amended.

The LIN '827 patent is directed to an intervertebral implant which includes a pair of walls 22a, 22b with an opening therebetween which prevents the barbs 24 from continuously extending from one side surface of the body to the other. Accordingly, the

LIN '827 patent fails to teach or suggest protrusions that are "continuously extending from one side surface of the body to the other side surface" as recited in claim 1. Therefore, the LIN '827 patent fails to cure the deficiencies of the LIN '158 device, and even assuming, arguendo, that the teachings of LIN '158 and LIN '827 have been properly combined, Applicants' claimed intervertebral spacer would not have resulted from the combined teachings thereof.

Further, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) over LIN '158 in view of LIN '827. In this regard, Applicants respectfully point out that the LIN '158 patent and the LIN '827 patent are directed to entirely different types of spacers.

The LIN '158 patent is directed to a spacer having a hole therein in which the spacer 100 has elastic slots 110, 111 therein that allow the spacer to be deformed when the spacer 100 is inserted into a bone. In other words, the spacer 100 of LIN '158 *requires* the elastic slots 110, 111 in order to deform. Without deformation, the LIN '158 device would not function.

However, the LIN '827 patent is directed to a spacer having a hole therein 27. The hole 27 of the LIN '827 device is filled with a bone graft bag. The bone graft material of LIN '827 would oppose any deformation of the spacer. This is in contradistinction to the *required* deformation of the LIN '158 device. Accordingly, the LIN '158 patent and the LIN '827 patent teach entirely different types of spacers. Therefore, there would be no need, nor would it be desirable, to combine the deformable LIN '158 device and the nondeformable LIN '827 device.

Thus, the only reason to combine the teachings of LIN '158 and LIN '827 results from a review of Applicants' disclosure and the application of impermissible hindsight. Accordingly, the rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) over LIN '158 in view of LIN '827 is improper for all the above reasons and withdrawal thereof is respectfully requested.

The Examiner has also rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Lin '158 in view of LIN '827, and further in view of BRANTIGAN (U.S. Patent No. 5,425,772).

Although Applicants do not necessarily agree with the Examiner's rejection of claim 6 on this ground, nevertheless, Applicants have amended independent claim 6 to clearly obviate the above noted ground of rejection in order to expedite prosecution of the present application. Applicants respectfully submit that LIN '158; LIN '827; and BRANTIGAN fail to teach or suggest the subject matter claimed in claim 6, as amended. In particular, claim 6 sets forth an intervertebral spacer having a withdrawal preventer including, inter alia, "a body defined by a pair of upper and lower surfaces, a pair of side surfaces connected to the upper and lower surfaces, a front side of the intervertebral spacer, and a rear side of the intervertebral spacer"; and "wherein the withdrawal preventer comprises a plurality of linear claw portions continuously extending from one side surface of the body to the other side surface".

As described above, LIN '158 discloses a deformable device which requires elastic slots; and LIN '827 discloses a nondeformable device. Accordingly, LIN '158 and LIN '827 fail to teach or suggest the subject matter claimed in claim 1, as amended.

Further, BRANTIGAN fails to cure these deficiencies. Moreover, there is nothing in the cited prior art that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claim 6 under 35 U.S.C. § 103(a) over LIN '158 in view of LIN '827 and further in view of BRANTIGAN. In this regard, Applicants respectfully point out that the LIN '158 patent and the BRANTIGAN patent are directed to entirely different types of spacers. The BRANTIGAN patent is directed to a spacer having grooves 21 therein to be filled with bone graft material, providing a nondeformable spacer. However, as described above, the LIN '158 patent is directed to a spacer having a hole therein in which the spacer 100 has elastic slots 110, 111 that allow the spacer to be deformed when the spacer 100 is inserted into a bone. Therefore, the spacer 100 of LIN '158 must be deformable; and the spacer of BRANTIGAN is not deformable. Accordingly, the LIN '158 patent and the BRANTIGAN patent teach entirely different types of spacers.

Thus, the only reason to combine the teachings of LIN '158, LIN '827, and BRANTIGAN results from a review of Applicants' disclosure and the application of impermissible hindsight. Even if the teachings of LIN '158, LIN '827, and BRANTIGAN were combined, as suggested by the Examiner, the claimed combination would not result. Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) over LIN '158 in view of LIN '827 and further in view of BRANTIGAN is improper for all the above reasons and withdrawal thereof is respectfully requested.

Accordingly, Applicants respectfully request reconsideration and withdrawal of all the rejections, and an early indication of the allowance of claims 1, 2, and 4-6.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the proposed amendment is proper for entry since it merely clarifies the language of claims 1 and 6 describing the body and the claw portions thereon, which is an issue about which Applicants have already presented arguments (since claims 1 and 6 already included the phrase "the upper and lower surfaces of the body slant such that a distance between the upper and lower surfaces at the front side of the intervertebral spacer is greater than a distance between the upper and lower surfaces at the rear side of the intervertebral spacer") and it is also submitted that none of the references of record, considered alone or in any proper combination thereof, anticipate or render obvious Applicants' invention as recited in claims 1, 2, and 4-6. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

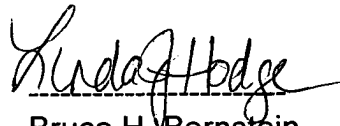
Accordingly, consideration of the present amendment, reconsideration of the outstanding Final Official Action, and allowance of the present amendment and all of the claims therein are respectfully requested and now believed to be appropriate.

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Any amendments to the claims which have been made in this amendment, which do not narrow the scope of the claims, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature, and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,
Shigenobu SATO et al.


Bruce H. Bernstein
Reg. No. 29,027

Linda J. Hodge
Reg. #47,348

May 30, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191